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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,555	01/31/2001	Mitchell Anthony DeLong	7996	4966

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MICHAEL BEST & FRIEDRICH, LLP  
100 E WISCONSIN AVENUE  
MILWAUKEE, WI 53202

EXAMINER

BADIO, BARBARA P

ART UNIT PAPER NUMBER

1617

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/774,555	<b>Applicant(s)</b> DELONG ET AL.	
	<b>Examiner</b> Barbara P. Badio, Ph.D.	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.  
4a) Of the above claim(s) 7,9,10,12 and 22-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,11 and 13-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**First Office Action on the Merits of a RCE**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 28, 2005 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Status of the Application***

3. Claims 1-44 are pending in the present application. Claims 22-44 stand withdrawn without traverse as being drawn to a nonelected invention. Claims 7, 9, 10 and 12 stand withdrawn from further consideration as being drawn to a nonelected species.

***Double Patenting***

**4. The provisional rejection of claims 1-6, 8, 11 and 13-21 under the judicially created doctrine of obviousness-type double patenting over claims of copending Application No. 09/774,557 is withdrawn.**

***Claim Objections***

5. Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The instant claim recites R<sup>3</sup> and R<sup>4</sup> are hydrogen atoms. However, the definition of R<sup>3</sup> and R<sup>4</sup> in parent claim 1 does not encompass hydrogen.

***Claim Rejections - 35 USC § 102***

**6. The rejection of claims 1-4, 6, 8, 11, 13-17 and 19-21 under 35 USC 102(b) over Wos et al. (WO 99/12895) is withdrawn.**

**7. The rejection of claim 5 under 35 USC 102(b) over Wos et al. (WO 99/12895) is maintained.**

The instant claim recites R<sup>3</sup> and R<sup>4</sup> are hydrogen atoms and, thus, the claimed invention is anticipated as stated in the previous Office Actions.

For this reason and those given in previous Office Actions, the rejection of claim 5 under 35 USC 102(b) over Wos et al. (WO 99/12895) is maintained.

***Claim Rejections - 35 USC § 103***

**8. The rejection of claims 1-6, 8, 11 and 13-21 under 35 USC 103(a) over Wos et al. (WO 99/12895) is maintained.**

Applicant argues the reference does not teach or suggest the presently claimed subject matter. According to applicant, the reference defines "R<sup>3</sup> and R<sup>4</sup> as only H, CH<sub>3</sub> and C<sub>2</sub>H<sub>5</sub>". Applicant's argument was considered but not persuasive for the following reason.

Contrary to applicant's assessment of the teaching of the cited prior art, it is noted that the definition of R<sup>3</sup> and R<sup>4</sup> by the reference is not limited to only H, CH<sub>3</sub> and C<sub>2</sub>H<sub>5</sub>. It should be noted that a reference is not limited to its working examples but is evaluated for what it teaches those of ordinary skill in the art. Like the instant invention, the cited prior art teaches R<sup>3</sup> and R<sup>4</sup> can be "OR<sub>10</sub> and SR<sub>10</sub>" (see page 7, lines 6-7 of the cited reference).

For this reason and those given in previous Office Actions, the rejection of claims 1-6, 8, 11 and 13-21 under 35 USC 103(a) over Wos et al. (WO 99/12895) is maintained.

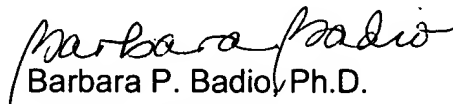
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***Telephone Inquiry***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Barbara P. Badio, Ph.D.  
Primary Examiner  
Art Unit 1617

BB  
January 4, 2006